



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 10/054,023              | 11/13/2001  | Raymond F. Cracauer  | FORS-06679          | 3272             |
| 7590                    | 09/27/2005  |                      | EXAMINER            |                  |
| MEDLEN & CARROLL, LLP   |             |                      | HANDY, DWAYNE K     |                  |
| Suite 350               |             |                      | ART UNIT            | PAPER NUMBER     |
| 101 Howard Street       |             |                      |                     |                  |
| San Francisco, CA 94105 |             |                      | 1743                |                  |

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/054,023             | CRACAUER ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Dwayne K. Handy        | 1743                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 13 June 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,5,6,20,22 and 24-30 is/are pending in the application.
  - 4a) Of the above claim(s) 25-30 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,5,6,20,22 and 24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's traversal of the Examiner's Restriction requirement in the reply filed on 6/13/2005 is acknowledged. The traversal is on the ground(s) that the method would not constitute an undue search for the Examiner and the Examiner's failure to provide any patents or other evidence. In addition, applicant has pointed out that the Examiner failed to provide an appropriate explanation of why the claims are properly assignable to different classes, require different searches or have separate status. The Examiner apologizes for this oversight. In claims 1, 5, 6, 20, 22 and 24 applicant has claimed an apparatus which is classified in 422/130. In claims 25-30, applicant has claimed a method for decreasing emissions. The method is classified in class 436/179. Therefore, the Examiner believes that the claims are restrictable even though the device of claim 1 is recited in the method claim since the method is classified in a different class than the device. This is especially true given the Examiner's belief that the Levin reference anticipates claim 1 of the device claims.

The requirement is still deemed proper and is therefore made FINAL. The Examiner notes applicant's statement to reserve the request reconsideration of these claims if any of the apparatus claims are allowed.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Levin et al. (6,432,365). This rejection was made in the previous Office Action and remains in effect.

#### *Inventorship*

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 6 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Levin et al. (6,432,365). This rejection remains in effect.
7. Claims 20, 22 and 24 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over McGowan et al. (6,328,627) in view of Heyneker et al. (6,264,981). This rejection remains in effect.

#### ***Response to Arguments***

8. Applicant's arguments filed 6/13/2005 have been fully considered but they are not persuasive. Applicant has argued that since Levin teaches a system that includes both a chamber top portion (420) and a venting cover (208), Levin does not anticipate claim 1. Applicant has also referred to Examiner's description of Levin from the Office Action. The Examiner acknowledges that two elements are being used to make the 102

rejection. The Examiner respectfully disagrees with applicant, however, that this precludes the use of Levin in a 102 rejection. As the Examiner stated in the last action, it is the Examiner's contention that the two elements mentioned by applicant meet the limitation of a "lid enclosure comprising a venting system". The Examiner reminds applicant that claim 1 has open language – "comprising". Therefore, the use of two elements to meet the broad limitation of a "lid enclosure comprising a venting system" is not excluded when making a 102 rejection. Top portion (420) and venting cover (208) combine to form the disputed feature – a lid enclosure that provides a vented workspace. When the lid enclosure is open, the workspace is of sufficient size to permit a hand to enter the chamber (112). Therefore, the Examiner still believes that Levin anticipates claim 1.

9. Applicant has also traversed the 103 rejection made using the references McGowan and Heyneker. Applicant has argued that the Examiner has not provided any motivation for combining the two references. The Examiner respectfully disagrees. The rejection under McGowan and Heyneker was originally made in the Office Action mailed 10/27/2003 (paragraph 11). This rejection was also addressed in the next Office Action (mailed 7/14/2004) in the Response to Arguments (paragraph 8). In the original rejection, the Examiner stated that one would add the vacuum system to remove fluids from the system as in Heyneker. Then, in the next Office Action, the Examiner expanded on this rejection by stating that Heyneker does not teach away from McGowan because the vacuum system of Heyneker drains liquids through the **bottom**

of the reactors. Given that the limitation containing the vacuum source is quite broad and requires no structural limitation other than being connected to the reaction system, the Examiner believes that one of ordinary skill in the art would certainly recognize that the use of the vacuum drain from the enclosed system of Heyneker would be advantageous to add to McGowan's block. The addition of the vacuum system would allow for the recovery of liquids from McGowan's reactors without taking apart the reaction block. This would save processing time. In addition, it would not interfere with the gas addition element of McGowan.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
September 15, 2005

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700